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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,152	10/16/2001	Sau-Spence Leung	5855-03-BHJ	4192

7590 07/10/2003
Warnr-Lambert Company
201 Tabor Rd.
Morris Plains, NJ 07950

EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/10/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,152

Applicant(s)

Leung et al.

Examiner

Kevin E. Weddington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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THE INDICATED ALLOWABILITY OF CLAIMS 26-41 IS WITHDRAWN IN VIEW OF THE NEWLY DISCOVERED REFERENCE(S) TO MARTIN ET AL. (A). REJECTIONS BASED ON THE NEWLY CITED REFERENCE(S) FOLLOW.

DOUBLE PATENTING

THE NONSTATUTORY DOUBLE PATENTING REJECTION IS BASED ON A JUDICIALLY CREATED DOCTRINE GROUNDED IN PUBLIC POLICY (A POLICY REFLECTED IN THE STATUTE) SO AS TO PREVENT THE UNJUSTIFIED OR IMPROPER TIMEWISE EXTENSION OF THE "RIGHT TO EXCLUDE" GRANTED BY A PATENT AND TO PREVENT POSSIBLE HARASSMENT BY MULTIPLE ASSIGNEES. SEE *IN RE GOODMAN*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *IN RE LONGI*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *IN RE VAN ORNUM*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *IN RE VOGEL*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); AND, *IN RE THORINGTON*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A TIMELY FILED TERMINAL DISCLAIMER IN COMPLIANCE WITH 37 CFR 1.321© MAY BE USED TO OVERCOME AN ACTUAL OR PROVISIONAL REJECTION BASED ON A NONSTATUTORY DOUBLE PATENTING GROUND PROVIDED THE CONFLICTING APPLICATION OR PATENT IS SHOWN TO BE COMMONLY OWNED WITH THIS APPLICATION. SEE 37 CFR 1.130(B).

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EFFECTIVE JANUARY 1, 1994, A REGISTERED ATTORNEY OR AGENT OF RECORD MAY SIGN A TERMINAL DISCLAIMER. A TERMINAL DISCLAIMER SIGNED BY THE ASSIGNEE MUST FULLY COMPLY WITH 37 CFR 3.73(b).

CLAIMS 26-41 ARE REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-14, 16-29 AND 32 OF U.S. PATENT NO. 5,658,956. ALTHOUGH THE CONFLICTING CLAIMS ARE NOT IDENTICAL, THEY ARE NOT PATENTABLY DISTINCT FROM EACH OTHER BECAUSE THE PRESENT APPLICATION TEACHES A BIOADHESIVE COMPOSITION COMPRISING A FILM FORMING AGENT, PYRUVATE, AN ANTIOXIDANT AND A MIXTURE OF SATURATED AND UNSATURATED FATTY ACIDS; AND THE PATENTED APPLICATION TEACHES A THERAPEUTIC BIOADHESIVE-WOUND HEALING COMPOSITION COMPRISING A BIOADHESIVE AGENT, A WOUND HEALING COMPOSITION CONTAINING A PYRUVATE, AN ANTIOXIDANT, AND A MIXTURE OF SATURATED AND UNSATURATED FATTY ACIDS. NOTE THE FILM FORMING AGENTS OR BIOADHESIVE AGENTS ARE CARBOXYMETHYLCELLULOSE AND METHYLCELLULOSE ARE THE SAME. THE PRESENT APPLICATION INSTANT BIOADHESIVE COMPOSITION CLEARLY READS ON THE PATENTED APPLICATION SINCE THE PRESENT APPLICATION'S COMPOSITION IS BROAD.

CLAIMS 26-41 ARE NOT ALLOWED.

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CLAIM REJECTIONS - 35 U.S.C. § 112

THE FOLLOWING IS A QUOTATION OF THE FIRST PARAGRAPH OF 35 U.S.C. 112:

THE SPECIFICATION SHALL CONTAIN A WRITTEN DESCRIPTION OF THE INVENTION, AND OF THE MANNER AND PROCESS OF MAKING AND USING IT, IN SUCH FULL, CLEAR, CONCISE, AND EXACT TERMS AS TO ENABLE ANY PERSON SKILLED IN THE ART TO WHICH IT PERTAINS, OR WITH WHICH IT IS MOST NEARLY CONNECTED, TO MAKE AND USE THE SAME AND SHALL SET FORTH THE BEST MODE CONTEMPLATED BY THE INVENTOR OF CARRYING OUT HIS INVENTION.

CLAIMS 27 AND 41 ARE REJECTED UNDER 35 U.S.C. 112, FIRST PARAGRAPH, AS CONTAINING SUBJECT MATTER WHICH WAS NOT DESCRIBED IN THE SPECIFICATION IN SUCH A WAY AS TO REASONABLY CONVEY TO ONE SKILLED IN THE RELEVANT ART THAT THE INVENTOR(S), AT THE TIME THE APPLICATION WAS FILED, HAD POSSESSION OF THE CLAIMED INVENTION.

APPLICANTS' SPECIFICATION DOES NOT TEACH OR DISCLOSE THE NEWLY ADDED FILM FORMING AGENTS THAT ARE USED IN THE INSTANT BIOADHESIVE COMPOSITION SUCH AS POLYVINYL PYRROLIDINE, CARBOXYVINYL POLYMERS, METHYLCELLULOSE, HYDROXYMETHYLCELLULOSE, HYDROXYPROPYLMETHYLCELLULOSE AND CARBOXYMETHYLCCELLULOSE AND SALTS THEREOF AND COMBINATIONS THEREOF. THE APPLICANTS' SPECIFICATION DOES NOT TEACH THE ADDITION OF CORTIZONE AS DISCLOSED IN CLAIM 41 WITH THE INSTANT BIOADHESIVE COMPOSITION.

CLAIMS 26 AND 41 ARE NOT ALLOWED.

CLAIMS 26-41 ARE REJECTED UNDER 35 U.S.C. 112, FIRST PARAGRAPH, BECAUSE THE SPECIFICATION, WHILE BEING ENABLING FOR FILMING FORMING AGENT SUCH AS PULLULAN, DOES NOT REASONABLY PROVIDE ENABLEMENT FOR FILM FORMING AGENTS

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SUCH AS POLYVINYL PYRROLIDONE, CARBOXYMETHYLCELLULOSE, CARBOXYVINYL
POLYMERS, METHYLCELLULOSE, HYDROXYMETHYLCELLULOSE AND
HYDROXPROPYLMETHYLCELLULOSE AND SALTS THEREOF AND COMBINATION THEREOF . THE
SPECIFICATION DOES NOT ENABLE ANY PERSON SKILLED IN THE ART TO WHICH IT PERTAINS,
OR WITH WHICH IT IS MOST NEARLY CONNECTED, TO MAKE THE INVENTION COMMENSURATE
IN SCOPE WITH THESE CLAIMS.

CLAIMS 26-41 ARE NOT ALLOWED.

CLAIM REJECTIONS - 35 U.S.C. § 102

THE FOLLOWING IS A QUOTATION OF THE APPROPRIATE PARAGRAPHS OF 35
U.S.C. 102 THAT FORM THE BASIS FOR THE REJECTIONS UNDER THIS SECTION MADE IN
THIS OFFICE ACTION:

A PERSON SHALL BE ENTITLED TO A PATENT UNLESS -

(B) THE INVENTION WAS PATENTED OR DESCRIBED IN A PRINTED PUBLICATION IN THIS OR A FOREIGN COUNTRY
OR IN PUBLIC USE OR ON SALE IN THIS COUNTRY, MORE THAN ONE YEAR PRIOR TO THE DATE OF
APPLICATION FOR PATENT IN THE UNITED STATES.

CLAIMS 26-41 ARE REJECTED UNDER 35 U.S.C. 102(B) AS BEING ANTICIPATED
BY MARTIN ET AL. (A).

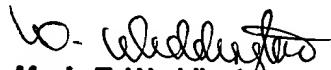
MARTIN ET AL. TEACH A THERAPEUTICAL BIOADHESIVE-WOUND HEALING COMPOSITION
THAT COMPRISES A BIOADHESIVE AGENT AND A WOUND HEALING COMPOSITION. NOTE THE
WOUND HEALING COMPOSITION COMPRISES PYRUVATE, AN ANTIOXIDANT AND A MIXTURE OF
SATURATED AND UNSATURATED FATTY ACIDS, SAME AS APPLICANTS. NOTE PARTICULARLY
THE BIOADHESIVE AGENTS ARE CARBOXYMETHYLCELLULOSE, METHYLCELLULOSE, GUAR

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GUM AND POLYCARBOPHIL, THE SAME AS APPLICANTS' FILM FORMING AGENTS AS DISCLOSED IN THE INSTANT SPECIFICATION. THE CITED REFERENCE ALSO TEACHES THE ADDITION OF OTHER AGENTS (SEE CLAIM 17) WHICH ARE THE SAME AS APPLICANTS' CLAIMS 28-40. CLEARLY, THE CITED REFERENCE ANTICIPATES THE APPLICANTS' INSTANT INVENTION, THEREFORE, THE INSTANT INVENTION OR BIOADHESIVE COMPOSITION IS UNPATENTABLE.

CLAIMS 26-41 ARE NOT ALLOWED.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO EXAMINER K. WEDDINGTON WHOSE TELEPHONE NUMBER IS (703) 308-1235.


Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. WEDDINGTON

JULY 7, 2003